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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,622

08/03/2006

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J3715(C)

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1611

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/550,622	<b>Applicant(s)</b> IVANOVA ET AL.	
	<b>Examiner</b> GINA C. YU	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,8,10,11,13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,8,10,11,13 and 15-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Receipt is acknowledged of amendment filed on March 16, 2009. Claims 1, 3-5, 7, 8, 10, 11, 13, 15-19 are pending. The claim rejections made in the previous Office action dated December 15, 2008 are withdrawn and modified to address the amended and/or new claims. A new rejection is made under 35 U.S.C. § 112, second paragraph, to address the claim amendment.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1, 4, 5, 8, 10, 11, 13, 18 and 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

It is not clear what is excluded from and permitted in the scope of the present composition because claim 1 excludes "silicone-based solvents" from the silicone pressure sensitive adhesive emulsion, but claim 18, a dependent claim, now requires "the silicone pressure sensitive adhesive comprises a silicone fluid". Since silicone-based solvents typically are silicone fluid, the claims are vague and indefinite as the metes and bounds of the scope of the claims are unclear.

The remaining claims are rejected as they depend on the indefinite base claim.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not in this action can be found in a prior Office action.

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**Claims 1, 3-5, 7, 8, 10, 11, 13, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapp (US 6887859).**

Clapp teaches topical liquid compositions comprising Bio-PSA, 40 % silicone pressure sensitive adhesive in isododecane for absorbing moisture and fluid absorbing. See Tables 3 and 5; instant claims 1, 4, 5, 10. Clapp suggests formulating the compositions into aerosol foams (mousse), which necessarily contains propellants, and to use the produce either a leave-on or rinse-off product. See col. 3, lines 49 – 67. See instant claims 7, 8. The use of the prior art invention for hair care is also taught therein. Addition of hair conditioning agent, such as emollient, and surfactants are also taught. See col. 11, lines 54 – 65; instant claim 1. While the reference does not specifically mention the type of surfactants used, selecting suitable ionic or nonionic surfactants to stabilize the emulsion would have been well within the skill of the art. Since the final composition comprising the silicone-PSA/isododecane solvent is made in the form of aqueous dispersion, there seems to be no distinction in the final prior art product and the instant invention.

While Clapp does not disclose a specific mousse formulation, the reference teaches and suggests aerosol foam comprising silicone PSA emulsion. Thus it would have been obvious to one of ordinary skill in the art at the time of the present invention to make mousse with improved fluid absorbing properties.

Applicant asserts the “consisting essentially of” language in the present claim 1 distinguishes the claimed invention from the prior art which comprises absorbent powder. The transitional phrase “consisting essentially of” limits the scope of a claim to

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the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). In this case, applicant does not exclude the presence of the prior art powder materials from the present invention because claim 18 requires silicate. Furthermore, there is no support in the specification that the presence of the absorbent powder materially affects what applicant regards as the basic novelty of the present invention, which is the use of PSA in isododecane in a hair styling composition.

**Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dhamdhere et al. (US 6787130 B2) in view of Torgerson (US 6165455).**

Dhamdhere teaches an aqueous hair treatment composition comprising at least one silicone PSA and at least one material selecting from a hair conditioning agent, a hair cleansing agent, and an agent for hair care suspension. See abstract. The reference teaches that silicone PSA emulsion is prepared by emulsifying the silicone with a volatile silicone fluid in water using one or more emulsifiers, preferably anionic or nonionic surfactants. See col. 4, line 64 – col. 5, line 10. Table 1, Examples 2-4 discloses compositions comprising DC 5-7300 (40 % silicone PSA emulsion), fatty alcohols and silicone fluids (hair conditioning agents). See instant claims 1-5, 9, 10. The reference teaches that the composition is used as a hair styling aid. See instant claim 11. The reference teaches that the use of PSA in the composition renders styling benefits without sticky feel. See col. 2, lines 54 – 61. See instant claims 11 and 13.

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While Dhamdhere does not specifically teach to formulate a mousse comprising at least one silicone PSA, the reference indicates that hair styling mousse is well known in hair care art.

Torgerson teaches hair styling mousse comprising hair styling polymers, including silicone copolymers, is well known in hair cosmetic art. A general formulation of a mousse is disclosed in Example 14, rendering the components of instant claim 15 obvious.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Dhamdhere and make mousse containing silicone PSA emulsion as motivated by Torgerson because the reference teaches that it is known in hair care art to use hair styling polymer to make hair styling mousse. While Dhamdhere teaches that the specific conditioning and styling agent (silicone PSA emulsion) are compatible with the shampoo ingredient, there is nothing in the reference that would have deterred a skilled artisan from making a hair styling mousse. The skilled artisan would have had a reasonable expectation of successfully producing a hair styling mousse which provides styling benefits without sticky feel.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1, 3-5, 7, 8, 10, 11, 13, 18, and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8-11 of copending Application No. 10/550623.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions comprising a silicone pressure sensitive adhesive wherein the pressure sensitive adhesive is in the form of an emulsion. The limitations of the dependent claims also overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 15-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Pat. No. Dhamdhere et al. (US 6787130 B2) in view of Torgerson et al. (US 6165455 A).**

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions comprising a silicone pressure sensitive adhesive wherein the pressure sensitive adhesive is in the form of an emulsion. The limitations of the dependent claims also overlap.

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Dhamdhere does not claim a mousse comprising at least one silicone PSA.

Torgerson teaches hair styling mousse comprising hair styling polymers, including silicone copolymers, is well known in hair cosmetic art.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Dhamdhere and make mousse containing silicone PSA emulsion as motivated by Torgerson because the reference teaches that it is known in hair care art to use hair styling polymer to make hair styling mousse.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-5, 8, 10, 11, 13, 15-19 have been considered but are moot in view of the new ground(s) of rejection.

Applicant asserts the presently claimed styling mousse formulation comprising PSA emulsion in isododecane has "a real and critical effect on the styling performance of pressure sensitive adhesive emulsion" when compared to PSA in a silicone-based solvent. Applicant's argument with respect to the rejection made in view of Clapp is moot in view of the new grounds of rejection above.

Applicant also asserts Clapp does not reasonably disclose compositions suitable for hair styling application. However, hair styling application is an intended future use of the composition, and there is nothing in the record to indicate that the prior art topical PSA composition for hair or skin is unsuitable for application to hair.

Applicant asserts the preferred PSA emulsion in Dhamdhere contains volatile silicone fluid. The rejection with respect to claims 15-17 are maintained because these claims do not exclude silicone-based solvent, and the use of silicone PSA for hair



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styling benefit is already taught by the prior art. Applicant points out to the specification which describes a comparison test on hair curl retention effects of two silicone PSA emulsions, each containing isododecane and 1 cts silicone fluid; however, the significance of the data is not clear from the disclosure. Applicant's disclosure appears to describe the difference in degree between hair styling effects of the commercially available PSA emulsions, when Dhamdhere already teaches hair styling benefits of silicone PSA emulsion generally and Clapp also teaches hair application of silicone PSA/isododecane emulsion. The mere discovery of differences in degree in the hair styling results as applicant has done in this case is not viewed a patentable subject matter.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/  
Primary Examiner, Art Unit 1611